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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,812	11/23/1999	KAZUROU OKUZAWA	00169/P17508	3098

7590 05/17/2005
WENDEROTH LIND & PONACK
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WASHINGTON, DC 20006

EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/380,812	Applicant(s) OKUZAWA ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as obvious over Sato et al. (US 5,753,727).

In light of applicant's response including the rule 1.132 Declaration, the 102(e) rejection over this reference has been withdrawn, it being agreed that the present claim requirement that the composition "consists essentially of" the recited components would define over the specific and particular examples in the reference (i.e. using the 50-50 mixture). However, the 35 USC 103 rejection will be maintained at this point as it is still considered that the disclosure in the reference for including "a chloroprene rubber," particularly when taken in light of the examples that show that that this language is considered to be generic to chloroprene whether carboxylated or uncarboxylated, would have been read as more broadly suggesting amounts of carboxylated chloroprene rubber not inconsistent with the present claim requirements. However, note the discussion to follow with respect to possible amendments to avoid this rejection by bringing the claims more commensurate with applicant's arguments.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (US 5,753,727) as applied to claim 1 above, and further in view of the admitted state of the prior art as applied in the last office action.

4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted state of the prior art taken in view of Smith (US 3,347,837) and/or the Kirk-Other Encyclopedia of Chemical technology excerpt (particularly sections 3.4 and 8.2)

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and optionally further in view of Sato et al. (US 5,753,727) and/or the abstract for JP 1-153781 (cited by applicant) as applied in the last office action.

This rejection is maintained for the reasons of record but likewise would be overcome with the below noted possible amendments to the claims to bring the claims more commensurate with applicant's arguments.

5. Applicant's arguments and rule 1.132 declaration filed 2-23-2005 have been fully considered but they are not persuasive at least as regards the remaining rejections.

Applicant's arguments stress that the present invention requires "**100 parts by weight** of **carboxylated** synthetic chloroprene rubber" and as such, the carboxylated rubber is "the **main** ingredient" of the adhesive composition (emphasis in original). This argument has been carefully considered but again is considered to be unpersuasive and seems to be reading the claim in a manner that is not at present considered to be consistent with the claim language. In particular, the present claim requirement that the composition contains 100 parts by weight of the carboxylated polymer (and 1-30 parts by weight of the chlorinated polypropylene) does not define that it is the main ingredient or otherwise exclude the presence of non-carboxylated chloroprene. Rather, the number "100" in the claim language (i.e. that refers to 100 parts by weight) is only at present relevant to the extent that it defines the *relative* proportions of the carboxylated chloroprene and chlorinated polypropylene - it does not express or require any further limitation. However, it would seem that applicant may be reading the claims as if this 100 parts by weight is actually "100 **PHR**" (that is, 100 parts per hundred parts rubber), in which case the entire rubber component of the composition would be required to be

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all in the form of carboxylated synthetic chloroprene rubber (as in the examples), it being noted that "PHR" is well known to the ordinary artisan and very commonly used to describe rubber based compositions (and used by applicant at for example page 4, line 15 of the specification). Note also that on page 1 of the 2-23-2005 declaration of Okuzawa, reference is expressly made to "100 PHR of carboxylated synthetic chloroprene rubber" (emphasis added). If the claims are to be so read, then appropriate amendment to change "parts by weight" to "PHR" at claim 1, lines 4 and 5 and claim 3, lines 5 and 6, is suggested. With such an amendment, the claims would be allowable absent additional art as the closest prior art would not reasonably suggest or render obvious an adhesive composition or process as claimed in which the composition consists essentially of 100 PHR carboxylated synthetic chloroprene rubber and 1-30 PHR of the recited polypropylene(s), it being stressed that although the applied prior art would suggest some advantageous properties for carboxylated chloroprene rubber adhesives themselves, it does not reasonably teach or render obvious providing an adhesive consisting essentially of the combined components as claimed, the entire rubber component of the composition being carboxylated synthetic chloroprene rubber.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
May 14, 2005